

Appl. No. 10/044,484
Amdt. dated October 3, 2005
Reply to Office Action of July 6, 2005

PATENT

REMARKS/ARGUMENTS

Claims 1-24 were pending in this application. Claims 1, 10, and 18 have been amended. No claims have been added or canceled. Hence, claims 1-24 remain pending. Reconsideration of the subject application as amended is respectfully requested.

Claims 1-5, 7-13, 15-20, 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,745,211 to Kabaskalian, *et al.* (hereinafter “Kabasakalian”), and further in view of the cited portions of U.S. Patent Publication No. 2003/0004724 A1 to Kahn, *et al.* (hereinafter “Kahn”).

Claims 10, 18 and 24 stand rejected by the same rationale as state in independent Claim 1 arguments.

Claims 11-13, 15-17, 19-20 and 22-23 have similar limitations as stated in dependent Claims 2-5 and 7-9 and stand rejected under the same subject matter.

Claims 6, 14 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kabasakalian, in view of Kahn and further in view of the cited portions of U.S. Patent No. 6,658,622 to Aiken, *et al.* (hereinafter “Aiken”).

Claims 1, 10, and 18 have been amended to more clearly recite the Applicants' claimed invention.

Claim Rejections Under 35 U.S.C. § 103(a)

The Applicant respectfully traverses the rejection of all claims, because the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations, the suggested

Appl. No. 10/044,484
Amdt. dated October 3, 2005
Reply to Office Action of July 6, 2005

PATENT

motivation fails to motivate one to combine the references, and the combination would not result in a working embodiment.

Claim 1 includes the limitation, "in response to an input that designates at least one field as a key segment," which Kabasakalian does not teach. The office action appears to confuse an input that designates a field to be a key segment, as claimed, with a user inputting data, which Kabasakalian teaches at the cited location. Hence, there being no designation of a key segment, the remaining claim elements relating to actions taken based on the key segment have no related teaching in the cited reference. You cannot take actions based on something (key segment) that does not exist because it has not been designated.

Moreover, although the Applicants believe this distinction was clear prior to the amendments herein, the Applicants have amended claim 1 to clearly avoid the teaching of Kabasakalian by including, "wherein a key segment comprises a field having pre-populated data and wherein the key segment field is common to each of a plurality of the records." This limitation is not taught or suggested by Kabasakalian and the Applicants are unable to locate this teaching in any of the other cited references. According to Kabasakalian, for example, the only element that could be construed to be a key segment is not prepopulated. Hence, claim 1 is believed to be allowable at least for this reason.

Further, the office action states that Kabasakalian does not teach the matching data from the first and second files. Actually, Kabasakalian does not teach the "field includes a copy of the matching data from the first and second files." Kahn also does not teach this. The audio files of Kahn do not include fields, so the field cannot include "a copy of the matching data from the first and second files" as the Applicants claim. Hence, for at least these reasons, claim 1 is believed to be allowable.

Further still, the cited references are unrelated. Kabasakalian relates to verifying data records. Kahn relates to audio files. The audio files are not organized into records having fields containing data. Hence, Kahn is non-analogous art with respect to both Kabasakalian and the Applicants' claimed invention. This destroys both the motivation to combine the references and the reasonable expectation of success. To wit, there can be no motivation to combine references when an important feature, comparing date in fields of records, has no relationship to

Appl. No. 10/044,484
Amdt. dated October 3, 2005
Reply to Office Action of July 6, 2005

PATENT

one of the references. Further, there is no teaching in either reference how the compared data can find its way into the audio files of Kahn. Hence, the combination would not result in a working embodiment of the Applicants' claimed invention. Claim 1 is, therefore, believed to be allowable, at least for this additional reason.

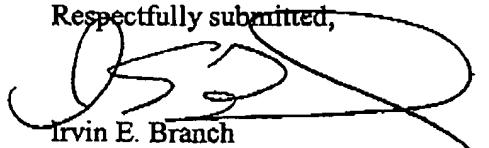
Claims 10 and 18 include similar limitations and are believed to be allowable, at least for the reasons stated above. The remaining claims depend from one of claims 1, 10, and 18, and are believed to be allowable, at least for the reasons stated above.

CONCLUSION

In view of the foregoing, the Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB:arl
60537949 v1